



UNITED STATES PATENT AND TRADEMARK OFFICE

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COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
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AUG 12 2002

In re

:  
:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 CFR 10.7(c)  
:

**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading his answers to questions 17 and 18 of the morning section and questions 6, 24, 33, 41, and 48 of the afternoon section of the Registration Examination held on October 17, 2001. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 68. On December 4, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under 35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 CFR 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the USPTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a court decision, a notice in the Official Gazette, or a notice in the Federal Register. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct

answer is the answer that refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has not been granted additional points on the Examination. No credit has been awarded for morning questions 17 or 18 and afternoon questions 6, 24, 33, 41, or 48. Petitioner's arguments for these questions are addressed individually below.

The following facts apply to Questions 16 and 17.

Claims 1 and 2, fully disclosed and supported in the specification of a patent application having an effective filing date of March 15, 2000, for sole inventor Ted, state the following:

Claim 1. An apparatus intended to be used for aerating water in a fish tank, comprising:

- (i) an oxygen source connected to a tube, and
- (ii) a valve connected to the tube.

Claim 2. An apparatus as in claim 1, further comprising an oxygen sensor connected to the valve.

Morning question 17 reads as follows:

17. Which of the following, if relied on by an examiner in a rejection of claim 2, can be a statutory bar under 35 U.S.C. § 102 of claim 2?

(A) A U.S. patent to John, issued February 2, 1999, that discloses and claims an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, and a battery coupled to the oxygen source.

(B) A U.S. patent to John, issued April 6, 1999, that discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.

(C) A U.S. patent to Ned, issued February 9, 1999, that discloses, but does not claim, an apparatus intended to be used for aerating ice cream, having an oxygen source connected to a tube, a valve connected to the tube, an oxygen sensor connected to the valve, and a battery coupled to the oxygen source.

(D) A foreign patent to Ted issued April 12, 2000, on an application filed on March 12, 1997. The foreign patent discloses and claims an apparatus intended to be used for aerating water in a fish tank, having an oxygen source connected to a tube, a valve connected to the tube, and an oxygen sensor connected to the tube.

(E) None of the above.

The model answer is selection (C).

35 U.S.C. § 102(b). MPEP § 2111.02 provides that the preamble generally is not accorded patentable weight where it merely recites the intended use of a structure. (A) is incorrect because it does not disclose an oxygen sensor. (B) is incorrect because the patent is not more than one year prior to the date of the Ted's application. (D) is incorrect because the foreign patent application issued after the date of Ted's application.

35 U.S.C. § 102(d). (E) is incorrect because (C) is correct.

Petitioner argues that there are different statutory bars provided in 35 U.S.C. § 102 and accordingly, many of the answers may in fact provide a statutory bar to the invention. Petitioner argues that answers (B) and (D) are statutory bars respectively under 35 USC §102 (e) and 35 U.S.C. § 102(a) respectively.

Petitioner's arguments have been considered but respectively are not deemed persuasive. MPEP § 2133.01 states "A rejection under 35 U.S.C. 102(b) cannot be overcome by affidavits and declaration under 37 CFR 1.131 (Rule 131 declarations), foreign priority dates, or evidence that applicant himself invented the subject matter. Outside the 1-year grace period, applicant is barred from obtaining a patent containing any anticipated or obvious claims." 35 U.S.C. 102(b) creates a statutory bar to the patentability of the claims, while 35 U.S.C. 102 (a) or (e) does not create a statutory bar because such sections can be overcome by affidavits. Accordingly, answer choice (B) is not a statutory

bar. Answer choice (D) cannot be relied upon because it is not prior art. See 35 USC 102(d). The correct choice is answer choice (C).

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 18 reads as follows:

18. Which of the following is in accord with proper USPTO practice and procedure?

(A) Satisfaction of the enablement requirement of the first paragraph of 35 U.S.C. § 112 by the disclosure in a specification also satisfies the written description requirement of the second paragraph of 35 U.S.C. § 112.

(B) A claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a process eligible for patent protection.

(C) A claim for a machine can encompass only one machine, such as a single computer, for performing the underlying process.

(D) A claim that recites nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are statutory natural phenomena.

(E) A composition of matter is a single substance, as opposed to two or more substances, whether it be a gas, fluid, or solid.

The model answer is selection (B).

MPEP § 2106 (IV)(B)(2)(b)(ii) (Computer Related Process ...), "If the 'acts' of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Thus, a claim to a process consisting solely of mathematical operations, i.e., converting one set of numbers into another set of numbers, does not manipulate appropriate subject matter and thus cannot constitute a statutory process." (A) is not correct. MPEP § 2106 (V)(B)(1), and see *In re Barker*, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), *cert. denied*, *Barker v. Parker*, 434 U.S. 1064 (1978) (a specification may be sufficient to enable one skilled in the art to make and use the invention, but still fail to comply with the written description requirement). See also *In re DiLeone*, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (CCPA 1971). Also, the written description requirement is in the first paragraph, not the second paragraph, of 35 U.S.C. § 112. (C) is not correct. MPEP § 2106 (IV)(B)(2)(a) (Statutory Product Claims). (D) is not correct. MPEP § 2106 (IV)(B)(1)(c) (Natural Phenomena Such As Electricity or Magnetism), and see *O'Reilly v. Morse*, 56 U.S. (15 How.) at 112 - 114. (E) is incorrect. MPEP § 2106 (IV)(B)(2) (Statutory Subject Matter),

and see *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 206 USPQ 193, 197 (1980); and *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 USPQ 265, 266 (D.D.C. 1957), *aff'd per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958).

Petitioner argues that the question is inherently ambiguous and that all answer choices should be considered correct. Petitioner argues that answer choice (E) may also be a correct answer choice.

Petitioner's arguments have been considered but such are not deemed persuasive. First, it is noted that Petitioner has the burden of showing that his answer choice (D) is the most correct answer. Petitioner did not discuss the correctness of answer choice (D). Answer (D) is not correct. MPEP § 2106 (IV)(B)(1)(c) states that a claim citing only the physical characteristics of a form of energy is a nonstatutory natural phenomena. See MPEP § 2106 (IV)(B)(1)(c) (Natural Phenomena Such As Electricity or Magnetism), and see *O'Reilly v. Morse*, 56 U.S. (15 How.) at 112 - 114. This is contrary to answer choice (D) which says such natural phenomena are statutory. Accordingly, answer choice (D) cannot be the most correct answer. Petitioner has not meet his burden of showing that answer choice (D) is the most correct answer. In response to Petitioner's assertion that answer choice (E) could also be correct, MPEP § 2106 (IV)(B)(2)(Statutory Subject Matter) specifically states "[a] composition matter is a composition of two or more substances...". Accordingly, the most correct answer choice is answer choice (B) for the reasons stated above.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 6 reads as follows:

6. An examiner has advanced a reasonable basis for questioning the adequacy of the enabling disclosure in the specification of your client's patent application, and has properly rejected all the claims in the application. The claims in the application are drawn to a computer program system. In accordance with proper USPTO practice and procedure, the rejection should be overcome by submitting \_\_\_\_\_

(A) factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone.

(B) arguments by you (counsel) alone, inasmuch as they can take the place of evidence in the record.

(C) an affidavit under 37 CFR 1.132 by an affiant, who is more than a routineer in the art, submitting few facts to support his conclusions on the ultimate legal question of sufficiency, i.e., that the system "could be constructed."

(D) opinion evidence directed to the ultimate legal issue of enablement.

(E) patents to show the state of the art for purposes of enablement where these patents have an issue date later than the effective filing date of the application under consideration.

The model answer is selection (A).

MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)). Factual evidence directed to the amount of time and effort and level of knowledge required for the practice of the invention from the disclosure alone can rebut a prima facie case of nonenablement. See *Hirschfield v. Banner*, Commissioner of Patents and Trademarks, 200 USPQ 276, 281 (D.D.C. 1978). (B) is not correct. MPEP § 2106.02 (Arguments of Counsel), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); *In re Schulze*, 145 USPQ 716 (CCPA 1965); and *In re Cole*, 140 USPQ 230 (CCPA 1964). (C) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)), and see *In re Brandstadter*, 179 USPQ 286 (CCPA 1973). (D) is not correct. MPEP § 2106.02 (Affidavit Practice (37 CFR 1.132)), and see *Hirschfield v. Banner*, Commissioner of Patents and Trademarks, 200 USPQ 276, 281 (D.D.C. 1978). (E) is not correct. MPEP § 2106.02, (Referencing Prior Art Documents), and see *In re Budnick*, 190 USPQ 422, 424 (CCPA 1976); and *In re Gunn*, 190 USPQ 402, 406 (CCPA 1976).

Petitioner argues that answer choice (C) is just as correct an answer as answer choice (A). Petitioner argues that answer choice (A) is problematic in that its not just the level of knowledge to practice the invention that has to be detailed but also the level of skill in the art.

Petitioner's arguments have been fully considered but are not deemed persuasive. Petitioner has the burden of showing that his answer choice is the most correct answer. However, petitioner's answer choice cannot be the most correct answer because the choice is clearly wrong. Answer choice (C) is wrong because an affidavit by an affiant who is more than a routineer in the art is not probative as to whether the invention would require undue experimentation. On the other hand, answer choice (A) is a correct statement that factual evidence directed to the amount of time and effort and level of knowledge for the practice of the invention would be probative of whether the invention was enabled. Accordingly, answer choice (C) is not the most correct answer and therefore Petitioner has not met the burden of showing that his answer choice is the most correct answer choice.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 24 reads as follows:

24. Pete wants to file a protest against a patent application filed by a coworker. In the locker room at his place of employment, Pete overheard Sol talking about an application for a golf ball retriever. Pete feels that the invention strongly resembles a golf ball retriever device published in a 1995 edition of Popular Golf magazine. Pete comes to you to file a protest. Pete wants to know if it will be considered by the examiner, and if the

applicant (Sol) is required to respond. Pete believes he heard Sol say the application was filed in May 2001, and wonders whether he should include evidence of fraud since Pete believes that his (Pete's) wife may have shown Sol the Popular Golf article. Which of the following is not accurate with respect to proper USPTO procedure in relation to applications filed on or after January 1, 2001?

(A) Pete's protest against Sol's pending application will be referred to the examiner having charge of the subject matter involved provided Pete can adequately identify the application. Protests that do not adequately identify a pending patent application will be returned to the protestor and will not be further considered by the Office.

(B) Pete's protest, provided it adequately identifies Sol's application, will be entered in the application file if:

- (1) the protest is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first; and
- (2) the protest is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible.

(C) If Pete submits evidence that his wife gave Sol a copy of the Popular Golf article and contends that Sol fraudulently copied the device from that disclosed in the article, the examiner will generally not comment on the issues related to fraud.

(D) Pete's protest, provided it adequately identifies Sol's application and is submitted prior to the date the application was published or the mailing of a notice of allowance under § 1.311, and which is either served upon Sol in accordance with § 1.248, or filed with the Office in duplicate in the event service is not possible, will be considered by the Office if the application is still pending when the protest and application file are brought before the examiner, and the protest includes:

- (1) a listing of the patents, publications, or other information relied upon;
- (2) a concise explanation of the relevance of each listed item;
- (3) a copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and
- (4) an English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.

(E) If Pete files the protest before the final office action, Sol has a duty to respond to the issues raised by Pete's protest even in the absence of a request by the USPTO for comments. If such issues are not addressed, the issues will be deemed admitted.

The model answer is selection (E).

37 CFR 1.291(c). In the absence of a request by the Office, an applicant has no duty to, and need not, reply to a protest. (A) contains portions of the elements of 37 CFR 1.291(a) & (b). (B) contains portions of the elements of 37 CFR 1.291(a). (C) contains portions of



the elements of 37 CFR 1.291(a) & (b). (D) contains portions of the elements of 37 CFR 1.291(a) & (b).

Petitioner argues that answer choice (A) cannot be correct and therefore the question should be disqualified and all answers be given credit. Petitioner argues that A cannot be a correct answer because it would be unethical to file the protest without more information by the applicant.

Petitioner's arguments have been considered but are not deemed persuasive. Assuming *arguendo* that A could be a correct answer, A is not the answer choice of Petitioner. The burden is on Petitioner to show that his answer choice (D) is the most correct answer. The question asks which response is NOT accurate in relations to USPTO procedure. Clearly, answer choice (D) is accurate with respect to USPTO practice. See 37 CFR 1.291(a) & (b). On the other hand, answer choice (E) is clearly not consistent with USPTO procedure because unless the Office requires a response, an applicant, (e.g., Sol) is not required to respond to the protest. See 37 CFR 1.291(c). Accordingly, answer (E) is correct while answer (D) is not a correct answer.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:

The following facts pertain to questions 33 and 34.

Applicant Sonny filed a patent application having an effective U.S. filing date of February 15, 2000. The application fully discloses and claims the following:

Claim 1. An apparatus for converting solar energy into electrical energy comprising:

- (i) a metallic parabolic reflector;
- (ii) a steam engine having a boiler located at the focal point of the metallic parabolic reflector; and
- (iii) an electrical generator coupled to the steam engine.

In a non-final Office action dated March 15, 2001, the examiner rejects claim 1 under 35 U.S.C. § 102(d) as anticipated by a patent granted in a foreign country to Applicant Sonny ("Foreign patent"). The Foreign patent was filed February 1, 1999, and was patented and published on January 17, 2000. The examiner's rejection points out that the invention disclosed in the Foreign patent is a glass lens with a steam engine having a boiler at the focal point of the glass lens, and an electrical generator coupled to the steam engine. The rejection states that the examiner takes official notice that it was well known by those of ordinary skill in the art of solar energy devices, prior to Applicant Sonny's invention, to use either a lens or a parabolic reflector to focus solar rays.

33. Sonny informs you that you should not narrow the scope of the claims unless absolutely necessary to overcome the rejection. Which of the following, in reply to the Office action dated March 15, 2001, is best?

(A) Traverse the rejection arguing that the examiner's use of the Foreign patent is improper because an applicant cannot be barred by a foreign patent issued to the same applicant.

(B) Amend claim 1 to further include a feature that is disclosed only in the U.S. application, and point out that the newly added feature distinguishes Sonny's invention over the invention in the Foreign patent.

(C) Traverse the rejection arguing that the examiner does not create a prima facie case of obviousness because the examiner does not show why one of ordinary skill in the art of solar energy devices would be motivated to modify the Foreign patent.

(D) Traverse the rejection arguing that the examiner's rejection under 35 U.S.C. § 102(d) was improper because claim 1 is not anticipated by the Foreign patent.

(E) Traverse the rejection arguing that it was not well known to use either a lens or a parabolic reflector to focus solar rays, and submit an affidavit under 37 CFR 1.132.

The model answer is selection (D).

MPEP § 706.02 points out the distinction between rejections based on 35 U.S.C. §§ 102 and 103. For anticipation under 35 U.S.C. § 102 the reference must teach every aspect of the claimed invention either explicitly or impliedly. (A), (B), (C), and (E) are each incorrect because each response does not address the lack of anticipation by the Foreign patent. (A) is further incorrect because an applicant can be barred under 35 U.S.C. § 102(d). (B) is further incorrect because the facts do not present the necessity of such an amendment. (C) is further incorrect because a prima facie case of obviousness is not necessary in a rejection under 35 U.S.C. § 102.

Petitioner argues that the best answer to the question would be answer choice (B) because traversing the rejection without any further action would have resulted in a waste of time, money and possible patent term. Petitioner argues that an amendment to the claims to anticipate and overcome the forthcoming § 103 rejection would be the proper course of action and the "best answer."

Petitioner's arguments have been considered but are not deemed persuasive. The question specifically mentions that the claim should not be amended unless absolutely necessary. Accordingly, the best response would not be to amend the claim if other responses are appropriate. Answer choice (B) would not be the best choice because the claims would have been unnecessarily amended. By traversing the rejection under answer choice (D), Sonny's desire not to amend the claims would be maintained and the rejection would have been obviated because of the lack of anticipation by the foreign patent. Answer choice (D) is the best choice.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 41 reads as follows:

41. Mark Twine obtains a patent directed to a machine for manufacturing string. The patent contains a single claim (Claim 1) which recites six claim elements. The entire interest in Twine's patent is assigned to the S. Clemens String Co., and Twine is available and willing to cooperate with S. Clemens String Co. to file a reissue application. A subsequent reissue application includes Claim 2, which is similar to original Claim 1. However, one of the elements recited in Claim 2 is broader than its counterpart element in the original claim. The remaining five elements are narrower than their respective counterpart elements in the original patent claim. Which of the following scenarios accords with USPTO proper practice and procedure?

- (A) The S. Clemens String Co. files the reissue application more than 2 years after the issue date of the original patent application.
- (B) The S. Clemens String Co. files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (C) Mark Twine files the reissue application less than 2 years after the issue date of the original patent but more than 2 years after original application filing date.
- (D) Mark Twine files the reissue application more than 2 years after the issue date of the original patent.
- (E) Mark Twine and the S. Clemens String Co. jointly file the reissue application more than 2 years after the issue date of the original patent.

The model answer is selection (C).

Answers (A), (D) and (E) are incorrect because a broadening reissue application must be filed within two years of issuance of the original patent. 35 U.S.C. § 251; MPEP § 1412.03. Answer (B) is incorrect because the assignee may not file a broadening reissue application. MPEP § 706.03(x).

Petitioner argues that answer choice (B) is the most correct answer and that answer choice (C) is incorrect because there is not a scintilla of evidence that assignee consented to the filing of the reissue application. Petitioner further argues that answer B meets all of the requirements because the inventor authorizes the filing and signing of the oath.

Petitioner arguments have been considered but are not deemed persuasive. First, the Office notes that the burden of persuasion is on Petitioner who is asserting that answer choice (B) is the most correct choice. Petitioner has not met his burden of persuasion.

35 USC § 251 states that “The provisions of this title relating to applications for patent shall be applicable to applications for reissue of patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.” (Emphasis added.)

37 CFR 1.172(a) states that a reissue oath must be signed and sworn to by the inventor or inventors except as otherwise provided (see §§ 142, 143, 147), and must be accompanied by the written consent of all assignees, if any, owning an undivided interest in the patent, but a reissue oath may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.” (Emphasis added.)

Accordingly, if an applicant seeks to enlarge the scope of the claims, then the application must be filed by the inventor unless the inventor is dead, insane, legally incapacitated, refuses to sign, or cannot be reached. (See 37 CFR §§ 1.42, 1.43, or 1.47). In the present factual scenario, none of these exceptions are present and accordingly answer choice (B) is an incorrect choice because the assignee cannot file the reissue application.

On the other hand, answer choice (C) is correct to the extent that the answer requires that the inventor file the reissue application. The factual scenario discloses that the reissue application is a broadening reissue application and accordingly pursuant to 35 USC § 251 the inventor must file the application. Although the factual scenario does not state whether or not the assignee consented to the application, answer choice (C) is a more correct answer because the answer is correct to the extent that it suggest that the inventor file the application.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 48 reads as follows:

48. Your longstanding client, Acme Chemical, comes to you for advice concerning a competitor’s patent that Acme fears might cover Acme’s key commercial product. Acme informs you that it began selling its product approximately eleven months before the competitor filed its patent application, and that a complete description of the product and how to make it was published in a trade magazine approximately ten months before the competitor’s December 8, 1999 application filing date. Acme asks you to recommend options short of litigation that might be available to challenge validity of the patent. Acme also asks that in making your recommendation you take into account that Acme will not challenge the patent’s validity unless it can be actively involved in all phases of the proceeding, even if that involvement will increase Acme’s costs. Which of the following is the most reasonable advice to Acme?

(A) You suggest that Acme request *ex parte* reexamination on the basis of the trade magazine publication and that Acme file a reply to any statement by the patent owner concerning any new question of patentability.

(B) You suggest that Acme request *ex parte* reexamination on the basis of Acme's prior sales and the trade magazine publication.

(C) You suggest that Acme request *inter partes* reexamination on the basis of the trade magazine publication only.

(D) You suggest that Acme request *inter partes* reexamination on the basis of Acme's prior sales and the trade magazine publication.

(E) You suggest that Acme inform the competitor in writing of the prior sales and trade magazine publication to force the competitor to inform the USPTO of this information and to force the competitor to initiate a reexamination of its own patent.

The model answer is selection (C).

Answers (B) and (D) are unreasonable advice at least because reexamination is available only on the basis of prior art patents or publications. See, e.g., 37 CFR 1.510, 1.552, 1.906 and 1.915. A request for reexamination may not properly rely upon evidence of public use or sales. Answer (A) is less reasonable than (C) at least because Acme will have the opportunity to submit a reply only if the patent owner chooses to file a statement under 37 CFR 1.530. 37 CFR 1.535. Any further proceedings would be completely *ex parte*. Acme has made it clear that it wants to participate in the proceedings. Answer (E) is less reasonable than (C) because a patent owner is not obliged to cite prior art to the USPTO in an issued patent. Also, the competitor would not be required to request reexamination. Indeed, the competitor would not be able to request reexamination unless the competitor had a good faith belief that the trade magazine article raised a substantial new question of patentability.

Petitioner argues that his answer choice (E) is the correct answer because of the inability to raise the sales issue in any reexamination. Moreover, Petitioner argues that the question asks legal advice beyond the scope of a patent agent. In addition, Petitioner argues that the "prior art" events are not necessarily prior art events under 35 USC 102(b) and may not be prior art under 35 USC 102(a) depending upon the date of the invention. Furthermore, Petitioner argues that while *inter partes* reexamination would not satisfy Acme's desire to participate in all phases of reexamination.

Petitioner's arguments have been considered but are not deemed persuasive. First, contrary to Petitioner's assertion, Petitioner chose Answer (A) not Answer (E) as asserted in the petition. The burden is upon Petitioner to prove that his answer choice is the most correct answer.

Answer choice (A) is not the most correct answer because *inter partes* reexamination would allow far greater third party participation than *ex parte* reexamination. Answer (A) is less reasonable than (C) at least because Acme will have the opportunity to submit a reply only if the patent owner chooses to file a statement under 37 CFR 1.530. 37 CFR

1.535. Any further proceedings would be completely *ex parte*. Acme has made it clear that it wants to participate in the proceedings. Accordingly, the most reasonable advice to give a third party requester seeking active participation in the reexamination process would be to file an *inter partes* reexamination rather than an *ex parte* reexamination.

As for Petitioner's argument that the question exceeds the permissible scope of exam questions, the Office notes that deciding whether to seek reexamination is clearly within the scope of authority that a patent agent must address if he is the agent for the applicant.

Moreover, Petitioner's arguments relating to whether or not the events may be "prior art events" under 35 USC 102(b) or 35 USC 102(a) assumes facts which are not part of the question. The facts state that the trade publication article was published ten months prior to the filing of the application in question. Accordingly, the trade magazine publication is prior art under 35 USC 102(a). Applicant may later prove that the invention was prior to the published article, however, that answer will be determined during the course of the reexamination.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, zero points have/has been added to petitioner's score on the Examination. Therefore, petitioner's score is 68. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above a horizontal line.

Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy